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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,504	10/30/2003	Steven W. Trovinger	10991471-13	9590

7590 10/21/2005
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

MACKEY, PATRICK HEWEY

ART UNIT PAPER NUMBER

3651

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/698,504	Applicant(s) TROVINGER ET AL.	
	Examiner Patrick H. Mackey	Art Unit 3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/831,768.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The amendment filed 8/30/2005 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bober in view of Albright et al. Bober discloses a method for stacking sheets of printing media that includes collecting the sheets on a workpiece (79) sheet by sheet; registering (80, 81) the sheets on the workpiece sheet by sheet; and unloading the stack from the workpiece (see col. 4, lines 30-33). Bober discloses all the limitations of the claims, but it does not disclose punching a hole/cutting a notch in the sheets, sheet by sheet. However, Albright discloses a sheet punching/cutting device that punches/cuts sheets, sheet by sheet, before transferring the sheets to a finisher for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once (see col. 2, lines 35-48). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Bober by punching/cutting the sheets sheet by sheet, as disclosed by Albright, for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved,

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more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once.

4. Claims 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell et al. in view of Albright et al. Farrell discloses a method for stacking sheets of printing media that includes punching a hole/cutting a notch in sheets (see col. 11, line 67); collecting the sheets on a workpiece sheet by sheet (see col. 11, line 20 incorporating U.S. 4,595,187 by reference); registering the sheets on the workpiece sheet by sheet (see col. 11, line 20 incorporating U.S. 4,595,187 by reference); and unloading the stack from the workpiece (see col. 11, lines 15-19). Farrell discloses all the limitations of the claims, but it does not disclose punching a hole/cutting a notch in the sheets, sheet by sheet. Rather, Farrell is silent as to how the punching/cutting occurs. However, Albright discloses a sheet punching/cutting device that punches/cuts sheets, sheet by sheet, before transferring the sheets to a finisher for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once (see col. 2, lines 35-48). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Farrell by punching/cutting the sheets sheet by sheet, as disclosed by Albright, for the purpose of punching/cutting sheets without interrupting their rapid sequential sheet printing and output, yet allowing improved, more positive, sheet control and a lower punching/cutting force as compared to compiling and hole punching/cutting through an entire set of sheets at once.

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (571) 272-6916. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'P. Mackey', with a large, stylized initial 'P' and a long, sweeping horizontal stroke extending to the left.

Patrick H. Mackey
Primary Examiner
Art Unit 3651

October 18, 2005